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REMARKS

The Examiner has rejected Claims 1-4, 7-11, 14-18 and 21 under 35 U.S.C. 102(b) as being anticipated by Arnold (U.S. Patent No. 5,440,723). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims. Specifically, applicant has amended each of the independent claims to substantially incorporate the subject matter of Claims 2-3 et al.

With respect to the subject matter of Claim 2 et al. (now at least substantially incorporated into each of the independent claims), the Examiner has relied on the following excerpt from Arnold to make a prior art showing of applicant's claimed technique "wherein said virus scanning logic is responsive to a library of tests to detect different computer viruses, said library including data specifying which computer viruses can cause changes that cannot be reversed by said virus cleaning and repair logic" (see the same or similar, but not necessarily identical language as presently incorporated into each of the independent claims, as amended).

"Block I: Clean up using VERV or backups

If VIRSCAN (Block G) has identified one or more infected files, an attempt is made to restore each infected file to an uninfected condition. VERV is capable of removing many of the most common viruses from infected files by determining whether the virus is an exact copy of one that it is capable of removing. If so, VERV removes the virus. If the virus cannot be removed by VERV, an automatic restore from a tape backup or from a read-only directory on a server, or from another machine on the network is attempted." (Col. 24, lines 43-53)

Applicant respectfully asserts that the above cited excerpt completely fails to even mention any sort of library, but instead only teaches removing viruses and restoring files. Clearly, only generally disclosing removing viruses does not meet applicant's specific claim language of "a library of tests to detect different computer viruses," let alone where such library particularly includes "data specifying which computer viruses can cause changes that cannot be reversed by said virus cleaning and repair logic."

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With respect to the subject matter of Claim 3 et al. (now at least substantially incorporated into each of the independent claims), the Examiner has relied on the following excerpt from Arnold to make a prior art showing of applicant's claimed technique "wherein said warning generating logic can generate one or more different types of warning to a user that said target computer file may have suffered irreparable damage and said library includes data specifying which of said plurality of types of warning should be issued in response to a particular detected computer virus" (see the same or similar, but not necessarily identical language as presently incorporated into each of the independent claims).

"If an automatic restoration of the infected file cannot be accomplished, the user receives a message describing the situation, with instructions for manually restoring the file from backup." (Col. 24, lines 54-57)

Applicant respectfully asserts that such excerpt only discloses sending a user a message with instructions for how to manually restore a file. Clearly, providing instructions to a user on how to manually repair a file does not meet applicant's claimed "warning...a user that said target computer file may have suffered irreparable damage" (emphasis added). Furthermore, such excerpt does not even suggest any sort of library, let alone where a library "includes data specifying which of said plurality of types of warning should be issued in response to a particular detected computer virus," as claimed (emphasis added).

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

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This criterion has simply not been met by the Arnold reference, especially in view of the amendments made hereinabove. A notice of allowance or a specific prior art showing of each of the foregoing claimed features, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 4 et al., the Examiner has relied on Col. 24, lines 13-14 and elements F, J and K of Figure 3 in Arnold to make a prior art showing of applicant's claimed technique "wherein said warning to a user that said target computer file may have suffered irreparable damage includes an option to add a notification message into said target computer file." Applicant respectfully asserts that such excerpt in Arnold only teaches that "[a] warning message is generated if VIRSCAN fails to find the virus." Furthermore, the Figure relied on by the Examiner only shows scanning a changed executable (element F), running decoy programs to determine if the decoy programs are modified (J), and isolating a viral portion of any decoy programs that are modified (K). Clearly, such does not even suggest any sort of warning with a specific "option to add a notification message into said target computer file," as claimed by applicant (emphasis added).

With respect to Claim 5 et al., presently rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold in view of Waldin (U.S. Patent No. 6,094,731), the Examiner has relied on Col. 6, lines 65-67 in Waldin to make a prior art showing of applicant's claimed technique "wherein said notification message includes authentication data identifying said target computer file into which it was inserted."

Applicant respectfully asserts that such excerpt only relates to examining the authenticity of a digital signature in a file where a digital signature is decrypted to produce a decrypted message digest, a new message digest of critical sectors is calculated, and the decrypted message digest and calculated message digest are compared (Col. 6 lines 51-67). Clearly, comparing message digests in the manner disclosed by Waldin does not even relate to any sort of notification message that "includes

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authentication data identifying said target computer file into which it was inserted,” as specifically claimed by applicant (emphasis added).

With respect to Claim 6 et al., also rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold in view of Waldin (U.S. Patent No. 6,094,731), the Examiner has relied on Col. 6, lines 50-56 in Waldin to make a prior art showing of applicant’s claimed technique “wherein said notification message includes an electronic signature applied by said warning generating logic.” Applicant again respectfully asserts that such excerpt does not even suggest any sort of notification message, but instead only relates to message digests associated with a file.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or a proper prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

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In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P503/00.147.01).

Respectfully submitted,
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